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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/779,569	02/13/2004	Alan G. Maloney	29954-701.201	8257

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EXAMINER	
AGRAWAL, RITESH	

ART UNIT	PAPER NUMBER
1631	

DATE MAILED: 08/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/779,569	MALONEY ET AL.	
	Examiner	Art Unit	
	Ritesh Agrawal	1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-103 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 1-103 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-51, 76, 101, and 102 drawn to translating disease classification identifiers, classified in class 707, subclass 102.

II. Claims 52-75, 77-100, and 103 drawn to translating genetic profiles, classified in class 702, subclass 20.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are directed to related processes. The related inventions are distinct if the inventions as claimed do not overlap in scope, i.e., are mutually exclusive; the inventions as claimed are not obvious variants; and the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 806.05(j). In the instant case, invention I is drawn to translating identifiers in a disease classification system whereas invention II is drawn to translating genetic profiles. Whereas invention one makes use of categories or identifiers comprised of words, invention II makes of genetic information. As a result, the two methods require different types of searching. Invention I requires semantic searching for related terms, whereas invention II requires sequence searching.

Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Species Election

The invention of group I contains claims directed to the following patentably distinct species:

A) disease classification system identifiers from the disease classification system (claims 2, 3)

B) disease classification system identifiers from the medical literature classification system (claims 4, 5).

The species are independent or distinct because they represent different sets of identifiers wherein those from set B will not require translation whereas those from set A will.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Furthermore, the invention of group I contains claims directed to the following patentably distinct species:

C) The SNOMED classification system (claim 7)

D) The ICD classification system (claims 8, 9, 10, and 11).

E) The ISCD Classification system (claim 12)

F) The CPT system (claim 13).

The species are independent or distinct because the different classification systems make use of different terminology to classify diseases wherein translation to the medical literature system will require different methods.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Furthermore, the invention of group I contains claims directed to the following patentably distinct species:

G) The MESH system (claim 14)

H) The Biosis system (claim 15).

I) The DISEASEDEX system (claim 16)

J) The DRUGDEX system (claim 17)

K) Faculty of 1000 system (claim 18)

L) National Guidance Clearinghouse System (claim 19)

M) Public Library of Science System (claim 20)

N) PsycINFO (claim 21).

The species are independent or distinct because the different classification systems make use of different keywords, headings, and terminology for classification and therefore translation to these systems from the disease systems will require different methods.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Furthermore, the invention of group I contains claims directed to the following patentably distinct species:

O) a generic evidence-based filter (claim 27)

P) a McMaster filter (claim 28)

Q) a University of York filter (claim 29)

R) a University of California San Francisco filter (claim 30).

The species are independent or distinct because they represent different means of filtering data. The different means of filtering data will make use of different methods and require varying input from the disease based system to provide appropriate results.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

The invention of group II contains claims directed to the following patentably distinct species:

A) Genetic Information (claims 53-60)

B) Genetic Proxies (claims 61-63).

The species are independent or distinct because they represent different types of genetic profile information wherein the different types of information will require different methods to be translated into the medical classification system.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 52 is generic.

Furthermore, the invention of group II contains claims directed to the following patentably distinct species:

C) The MESH system (claim 64)

D) The Biosis system (claim 65).

E) The DISEASEDEX system (claim 66)

F) The DRUGDEX system (claim 67)

G) Faculty of 1000 system (claim 68)

H) National Guidance Clearinghouse System (claim 69)

I) Public Library of Science System (claim 70)

J) PsycINFO (claim 71).

The species are independent or distinct because the different classification systems make use of different keywords, headings, and terminology for classification and therefore translation to these systems from the disease systems will require different methods.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 52 is generic.

Furthermore, the invention of group II contains claims directed to the following patentably distinct species:

K) a generic evidence-based filter (claim 77)

L) a McMaster filter (claim 78)

M) a University of York filter (claim 79)

N) a University of California San Francisco filter (claim 80).

The species are independent or distinct because they represent different means of filtering data. The different means of filtering data will make use of different methods and require varying input from the disease based system to provide appropriate results.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 52 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ritesh Agrawal whose telephone number is (571) 272-2906. The examiner can normally be reached on 8:30 AM - 5:00 PM M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ritesh Agrawal RA